



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

1/15 AF

Inventor(s): Reid F. Hayhow

Serial No.: 10/684,281

Examiner: Jalatee Worjoh

Filing Date: October 10, 2003

Group Art Unit: 3685

Title: ELECTRONIC LICENSING FOR DEVICE TESTER

COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria VA 22313-1450

TRANSMITTAL OF APPEAL BRIEF

Sir:

Transmitted herewith is the Appeal Brief in this application with respect to the Notice of Appeal filed on September 11, 2008.

The fee for filing this Appeal Brief is (37 CFR 1.17(c)) \$540.00.

(complete (a) or (b) as applicable)

The proceedings herein are for a patent application and the provisions of 37 CFR 1.136(a) apply.

(a) Applicant petitions for an extension of time under 37 CFR 1.136 (fees: 37 CFR 1.17(a)(1)-(5)) for the total number of months checked below:

<input checked="" type="checkbox"/>	one month	\$ 130.00
<input type="checkbox"/>	two months	\$ 490.00
<input type="checkbox"/>	three months	\$1110.00
<input type="checkbox"/>	four months	\$1730.00

The extension fee has already been filled in this application.

(b) Applicant believes that no extension of term is required. However, this conditional petition is being made to provide for the possibility that applicant has inadvertently overlooked the need for a petition and fee for extension of time.

Please charge to Deposit Account 08-2623 the sum of \$670.00. At any time during the pendency of this application, please charge any fees required or credit any overpayment to Deposit Account 50-4018 pursuant to 37 CFR 1.25.

A duplicate copy of this transmittal letter is enclosed.

Respectfully submitted,

Reid F. Hayhow

By /Gregory W. Osterloth/

10030552-1

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Date of Deposit: March 2, 2009 OR

I hereby certify that this paper is being submitted electronically via EFS-Web to the Patent and Trademark Office on the date shown below.

Date of submission:

Typed Name: Gregory W. Osterloth

Signature: /Gregory W. Osterloth/

Gregory W. Osterloth  
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Date: March 2, 2009

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Gregory W. Osterloth  
Attorney/Agent for Applicant(s)

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Typed Name: Gregory W. Osterloth

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Appl. No. : 10/684,281 Confirmation No. : 3341  
Appellant : Reid F. Hayhow  
Filed : October 10, 2003  
TC/A.U. : 3685  
Examiner : Jalatee Worjoh  
  
Docket No. : 10030552-1

Mail Stop Appeal Brief – Patents  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**AMENDED APPEAL BRIEF**

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APPEAL BRIEF

Dear Sir:

This Appeal Brief is submitted in response to the Examiner's Final Office Action mailed April 21, 2008, and the Notice of Panel Decision from Pre-Appeal Brief Review mailed December 31, 2008.

Appellants filed a Notice of Appeal on September 11, 2008.

03/09/2009 CCHAU1 00000038 082623 10684281  
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**Real Party in Interest**

The real party in interest is Verigy (Singapore) Pte. Ltd., a Singapore limited liability company.

**Related Appeals and Interferences**

Appellant is unaware of any related appeals.

### **Status of Claims**

Claims 14-25 are pending, all of which stand rejected. The rejections of claims 14-25 are appealed. Claims 1-13 have been canceled, without prejudice.

A copy of the claims is attached as a Claims Appendix to this Appeal Brief.

**Status of Amendments**

No amendments were made to the claims subsequent to final rejection. All amendments have been entered.

### **Summary of Claimed Subject Matter**

In one embodiment (claim 14), a system comprises: 1) a tester (FIG. 1, 100) to apply one or more tests to a device (FIG. 1, 150) (p. 3, lines 3-13; pars. [0008]-[0009]); and 2) logic (FIG. 1, 160), communicatively coupled to the tester, to enable one or more resources (e.g., FIG. 1, 101-132) of the tester according to one or more properties of an electronic license (FIG. 1, 170) and to create at least one log file having resource use information for one or more tests executed on the tester (p. 3, line 14 - p. 4, line 19; pars. [0010]-[0013]).

**Ground of Rejection to be Reviewed on Appeal**

Whether claims 14-25 should be rejected under 35 USC 102(e) as being anticipated by Organ et al. (US Pat. No. 7,191,368).

## Argument

### 1. Claims 14-25 should not be rejected under 35 USC 102(e) as being anticipated by Organ et al. (US Pat. No. 7,191,368; hereinafter “Organ”).

Appellant's claim 14 recites:

14. A system comprising:  
a tester to apply one or more tests to a device; and  
logic, communicatively coupled to the tester, to enable one or more resources of the tester according to one or more properties of an electronic license and to create at least one log file having resource use information for one or more tests executed on the tester.

With respect to claim 14, the Examiner asserts that:

...Organ discloses a tester to apply to one or more testes [sic] to a device (see abstract - an electronic tester; a test head is coupled to a device under test), logic, communicatively coupled to the tester, to enable one or more resources of the tester according to one or more properties of an electronic license (i.e. rule) (see col. 12, lines 4-6) and to create at least one log file having resources use information for one or more tests executed on the tester (see col. 14, lines 46-50).

4/21/2008 Final Office Action, p. 3.

Appellant respectfully disagrees. Organ's col. 12, lines 4-6, recites:

When a program is loaded, the information is resolved into specific attributes of the selected tester. Tester resource allocation and **rules** checking is performed at this time.

(Emphasis added)

The above is Organ's only mention of “rules”. Appellant asserts that nothing in the above excerpt mentions or implies that “rules checking” includes license checking. Nor

does the above excerpt mention or imply that Organ utilizes an "electronic license" to enable one or more resources of a tester. Further, it is noted that Organ's disclosure does not mention a "license" or "licensing" even once. As a result, appellant asserts that Organ is devoid of any teaching or suggestion of "logic. . .to enable one or more resources of [a] tester according to one or more properties of an electronic license"; and ***one of ordinary skill in the art, at the time of appellant's invention, would not have made the gigantic leap that Organ's "rules checking" might be replaced with 'licensing checking' and 'resource enablement'. This gigantic leap can only be made via hindsight reconstruction, using the disclosure of appellant's application as a guide. And even then, there is no basis for interpreting Organ's 'resolving of program information into specific attributes of a tester' as the enablement of tester resources (i.e., there is no support for interpreting tester attributes as tester resources).*** Claim 14 is believed to be allowable for at least these reasons.

The argument set forth above was first made in appellant's Amendment dated January 21, 2008. In the Examiner's April 21, 2008 Final Office Action, the Examiner responded to appellant's argument by asserting that the phrase "to enable one or more resources of [a] tester according to one or more properties of an electronic license" was merely a recitation of a new intended use for an old product (i.e., a new intended use for Organ's apparatus). Appellant respectfully disagrees.

The Examiner cites *In re Schreiber*, 44 USPQ2d 1429 (Fed. Cir. 1997) for the proposition that "the recitation of a new intended use of an old product does not make a claim to that old product patentable." However, the claims at issue in *Schreiber* were directed to a simple mechanical device - i.e., a generally conical shaped device for dispensing popcorn. In *Schreiber*, the court found that Schreiber's claim to a generally conical shaped device for dispensing popcorn was anticipated by a generally conical shaped device for dispensing oil. The court also found that the conical shaped device

for dispensing oil would *inherently* be able to perform Schreiber's function of "dispensing popcorn".

In contrast to the simple mechanical device that was at issue in *Schreiber*, appellant's claim 14 recites a system comprising "a tester" and "logic, communicatively coupled to the tester". Appellant's claim 14 also recites some functions that are performed by the logic. Nowhere does Organ teach or suggest that such functions are performed (inherently or otherwise) by any element of Organ's apparatus. At a minimum, the performance of the functions recited by appellant's claim 14 would require a reprogramming or reconfiguration of Organ's apparatus so that it could perform the new functions of appellant's claim 14. In other words, Organ's apparatus is not inherently capable of performing the functions of appellant's claimed "logic" - particularly, resource enablement.

The logic of appellant's claim 14 is indicated to be "communicatively coupled to the tester, **to enable one or more resources of the tester**". Even if one takes the position that appellant's claim 14 merely recites a new intended use for Organ's computer, and that a computer which undertakes "rules checking" could inherently perform "license checking", the fact remains that Organ does not disclose "logic. . .to enable one or more resources of the tester". That is, Organ does not indicate that "rules checking" is used to enable resources of a tester. Rather, Organ only discloses the use of "rules checking" for "tester resource allocation", the resolving of timing information, and the loading of programs. See, col. 12, lines 4-9. Appellant asserts that the "allocation" of tester resources is not equivalent to the "enablement" of tester resources, and "allocation" (i.e., deciding how enabled resources are used) does not suggest "enablement" (i.e., deciding whether resources are enabled at all). Thus, Organ not only fails to disclose license checking, but Organ also fails to disclose any structural or functional relationship between a "tester" and "logic" that allows the logic "to enable one or more resources of the tester."

The Examiner also rejects claim 14 on the basis that Organ, in col. 14, lines 46-50, discloses "logic. . .to create at least one log file having resource use information for one or more tests executed on [a] tester". Organ's col. 14, lines 46-50, recites:

...Button number 228 of operator tool 160 allows the user to turn on or turn off the enVision++ data log. When the envision data log is turned on, the measurements made during digital testing of DUT 50 are written to a file.

Area 239 of operator tool 160 is used to display status.

Appellant asserts that nothing in the above excerpt teaches the creation of a log file having "resource use information". That is, the enVision++ **data log** is only a "data log", or a log of "measurements made during digital testing". Organ does not indicate or suggest that the enVision++ log should additionally or alternately be used to log "**resource use information**", as recited in appellant's claim 14. Claim 14 is therefore believed to be allowable for this additional reason.

Of note, the Examiner has never responded to appellant's above argument concerning the failure of Organ to disclose "logic. . .to create at least one log file having resource use information for one or more tests executed on [a] tester".

For the reasons given above, appellant believes the Examiner has failed to state a *prima facie* basis for rejecting claim 14.

Claims 15-25 are believed to be allowable, at least, because they depend from claim 14. Each of claims 15-18 is also believed to be separately allowable, because Organ does not disclose that any of the particular types of resources specified in claims 15-18 can or should be "enabled" by an "electronic license". Furthermore, each of claims 21-24 is believed to be separately allowable, because Organ does not disclose that any of the particular types of "resource use information" recited in claims 21-24 can or should be logged.

**2. Conclusion**

In summary, the art of record does not teach nor suggest the subject matter of appellant's claims 14-25. These claims are therefore believed to be allowable.

Respectfully submitted,  
HOLLAND & HART, LLP

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## Claims Appendix

14. A system comprising:
  - a tester to apply one or more tests to a device; and
  - logic, communicatively coupled to the tester, to enable one or more resources of the tester according to one or more properties of an electronic license and to create at least one log file having resource use information for one or more tests executed on the tester.
15. The system of claim 14, wherein the logic is to enable an amount of memory available on the tester according to one of the properties of the electronic license.
16. The system of claim 14, wherein the logic is to enable a speed available on the tester according to one of the properties of the electronic license.
17. The system of claim 14, wherein the logic is to enable a number of waveforms available on the tester according to one of the properties of the electronic license.
18. The system of claim 14, wherein the logic is to enable a number of edge transitions available on the tester according to one of the properties of the electronic license.

19. The system of claim 14, wherein the tester comprises a system-on-a-chip (SOC) tester.
20. The system of claim 14, wherein the at least one log file having resource use information for one or more tests executed on the tester comprises at least one log file having resource use information for one or more tests executed on the device tester using the electronic license.
21. The system of claim 14, wherein the resource use information comprises information on an amount of time the tester is used.
22. The system of claim 14, wherein the resource use information comprises information on an amount of memory used by the tester during testing of the device.
23. The system of claim 22, wherein the information on the amount of memory used by the tester during testing of the device is a maximum amount of memory used by the tester over a predefined period of time.
24. The system of claim 14, wherein the resource use information comprises information on a speed at which tests are executed by the tester.

25. The system of claim 14, wherein the logic is to generate a usage report based on the at least one log file.

## **Evidence Appendix**

None.

**Related Proceedings Appendix**

None.